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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,319	02/25/2004	Daniel Zuzuly	2004P02541US (00355P0126U)	2648
7590 04/09/2007 Elsa Keller SIEMENS CORPORATION Intellectual Property Dept. 170 Wood Avenue South Iselin, NJ 08830			EXAMINER VO, HIEN XUAN	
			ART UNIT 2863	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/786,319	ZUZULY ET AL.	
	Examiner	Art Unit	
	Hien X. Vo	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims 1-10 are directed to a judicial exception, as such, pursuant to the Interim guidelines on Patent Eligible Subject Matter (MPEP 2106), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claim appear useful and concrete, there does not appear to be a tangible result claimed. Merely, providing a motor controller including solid state switches for controlling application of power to the motor, and a control circuit for controlling operation of the solid state switches and for measuring electrical power system characteristics relating to operation of the solid state switches; providing an external monitoring and diagnostic device; establishing communications between the control, circuit and the external monitoring and diagnostic device would not appear to be sufficient to constitute a tangible result, since the outcome of periodically transferring parameters of the measured electrical power system characteristics from the control circuit to the external monitoring and diagnostic device to monitor electrical power system characteristics in real time step has not been used in a disclosed practical application nor made available

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in such a manner that its usefulness in a disclosed practical application can be realized.

As such, the subject matter of the claims is not patent eligible.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-18, 20-27 rejected under 35 U.S.C. 102(b) as being anticipated by Bearden et al. (U.S. Patent No. 6,167,965).

With respect to claim 1, Bearden et al. disclose an electrical submersible pump and method for enhanced utilization of electrical submersible pumps in the completion and production of wellbores that includes providing a motor controller (see e.g. col. 10, lines 1-4) including solid state switches for controlling application of power to the motor (see e.g. col. 10, lines 41-43), and a control circuit for controlling operation of the solid state switches (see e.g. col. 10, lines 43-45) and for measuring electrical power system characteristics relating to operation of the solid state switches (see e.g. col. 10, lines 46-55); providing an external monitoring and diagnostic device (see e.g. cols. 11-12); establishing communications between the control circuit and the external monitoring and diagnostic device (see e.g. col. 11, lines 51-60); and periodically transferring parameters of the measured electrical power system characteristics from the control

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circuit to the external monitoring and diagnostic device to monitor electrical power system characteristics in real time (see e.g. col. 41, lines 9-22).

With respect to claims 2-5, Bearden et al. disclose the invention as claimed including a motor controller comprises providing a control circuit including a programmed processor for commanding operation of the solid state switches and a memory connected to the programmed processor for storing the parameters of the measured electrical power system characteristics (see e.g. col. 41, lines 48-56 and col. 42, lines 5-8), transferring parameters of the measured electrical power system characteristics comprises reading the stored parameters of the measured electrical power system characteristics from the memory (see e.g. col. 9, lines 63-65), providing a computer having a memory for storing the transferred parameters, providing a personal digital assistant having a memory for storing the transferred parameters (see e.g. Fig.4E), printing a listing of the transferred parameters of the measured electrical power system characteristics (see e.g. col. 38, lines 29-35), transferring parameters of the measured electrical power system characteristics comprises transferring the parameters at select time intervals (see e.g. col. 19, lines 56-60), the control circuit measures line voltage, motor voltage and motor current (see e.g. col. 7, lines 58-67 and col. 8, lines 1-11), a wired communication path between the control circuit and the external monitoring and diagnostic device (see e.g. col. 37, lines 32-42).

Claims 11-18 and 20-27 are apparatus claims corresponding to method claims 1-8 and 10. Therefore, claims 11-18 and 20-27 are rejected for the same rationales set forth for claims 1-8 and 10.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Bearden et al. (U.S. Patent No. 6,167,965) further in view of Jonsson et al. (U.S. Patent No. 6,984,950)

With respect to claims 9 and 19, Bearden et al. disclose the invention as claimed except for teaching an infrared communication path between the control circuit and the external monitoring and diagnostic device. However, Jonsson et al. disclose the system and method for configuring a motor controller with an external device including an infrared communication path between the control circuit and the external monitoring and diagnostic device (see e.g. claim 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bearden with an IR communication interface as taught by Jonsson to provide the communication link to reduce the interference with another wireless signal.

4. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien X. Vo whose telephone number is (571) 272-2282. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hien Vo
03/31/07


John Barlow
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